

05-09-03

1646

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DmT
5-16-03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Bendele *et al.*

Serial No.: 09/907,263

Group Art Unit No.: 1646

Filed: July 17, 2001

Examiner: E. B. O'Hara

For: COMBINATION THERAPY USING A TNF
BINDING PROTEIN FOR TREATING
TNF-MEDIATED DISEASES

RECEIVED

MAY 14 2003

Docket No.: A-430F

TECH CENTER 1600/2900

RESPONSE AND AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated December 31, 2002, Paper No. 12, please amend this application as follows:

In the Specification

At page 1, please replace the first paragraph with the following:

D1
This application is a divisional of application Serial No. 09/326,394 filed June 4, 1999, now United States Patent No. 6,306,820, which is a continuation of PCT/US97/22733, filed December 8, 1997, which claims benefit to U.S. Provisional Serial No. 60/032,587, filed December 6, 1996, U.S. Provisional Serial No. 60/036,355, filed January 23, 1997, U.S. Provisional Serial No. 60/039,315, filed February 7, 1997 and U.S. Provisional Serial No. 60/052,023, filed July 9, 1997, all of which are hereby incorporated by reference.

EXPRESS MAIL CERTIFICATE

"Express Mail" mail labeling number: EV 351340134 US

Date of Deposit: May 7, 2003

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Lynne Buchsbaum
Printed Name

Lynne Buchsbaum
Signature

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05/12/2003 551THB1 00000068 010519
410.00 CH
01 FC:1252

Appl. No. 09/830,709
Amdt. dated May 8, 2003
Reply to Office Action of February 10, 2003

In order to anticipate Applicants' claims, Young et al. must disclose each and every element set forth in the claim. *Verdegaal Bros. v. Union Oil*, 814 F.2d 628, 631 (Fed. Cir. 1987). Young et al. does not teach a DNA molecule having the nucleotide sequence of SEQ ID NO:1 or a polypeptide having the amino acid sequence of SEQ ID NO:2. Accordingly, Applicants respectfully request withdrawal of this rejection.

The Examiner rejected claim 10 under 35 U.S.C. § 102(b) as anticipated by Hiller et al., Database EST, May 21, 1996. Claim 10 has been canceled. Therefore, Applicants respectfully request withdrawal of this rejection.

Conclusion:

In light of the foregoing Amendment and Remarks, Applicants' assert the claims are in condition for allowance. Removal of all rejections and early notice of allowable claims is requested.

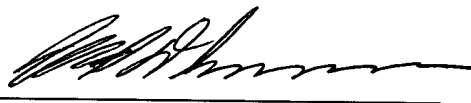
The Examiner is invited to telephone the undersigned attorney for clarification of any of these Remarks or Amendments, or to otherwise speed prosecution of this case.

Respectfully submitted,

MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
(612) 332-5300

Date: May 8, 2003





Michael D. Schumann
Reg. No. 30,422
MDS:EED:lek



FEE AUTHORIZATION / AMENDMENT TRANSMITTAL LETTER

Attorney's Docket No:
A-430F

Serial No.

09/907,263

Filing Date

July 17, 2001

Examiner

Eileen B. O'Hara

Group Art Unit

1646

In Re Application of
Bendele et al.

For

COMBINATION THERAPY USING A TNF BINDING PROTEIN FOR TREATING TNF-MEDIATED DISEASES

TO THE COMMISSIONER FOR PATENTS:

☒ Applicant(s) request(s) the following extension of time under 37 CFR 1.136(a):☐ One month of original due date (\$110.00)☒ Two months of original due date (\$410.00)☐ Three months of original due date (\$930.00)☐ Four months of original due date (\$1,450.00)☐ Five months of original due date (\$1,970.00)☒ A response in connection with the matter for which this extension is requested:☒ is filed herewith.☐ has been filed.☐ The response is the filing of a continuing prosecution application, the prior application having an express abandonment conditioned on the granting of a filing date to the continuing application.☒ The accompanying papers include amended claims for which no additional fee is required.☐ The accompanying papers include amended claims the fee for which has been calculated as follows:

CLAIMS AS AMENDED

| (1) | (2) Claims remaining After amendment | (3) | (4) Highest number Previously paid for | (5) No. of Extra claims present | (6) Rate | (7) Additional Fee |
|---|--|-------|--|---------------------------------------|-------------|--------------------------|
| Total Claims | * | Minus | ** | = | 0 | x \$18 = \$ 0.00 |
| Indep. Claims | * | Minus | *** | = | 0 | x \$84 = 0.00 |
| <input type="checkbox"/> First Appearance of a multiple dependent claim | | | | | + | \$280 = 0.00 |
| Total Additional Fee for this Amendment | | | | | | \$0.00 |

* If the entry in column 2 is less than the entry in column 4, write "0" in column 5.

** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, write "20" in this space.

*** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest No. Previously Paid For" (Total or Indep.) is the highest number found in the appropriate box in Col 1. of a prior amendment or the number of claims originally filed.

☐ The following other fees are incurred by the accompanying papers.☐ Other: _____

Please charge Deposit Account No. 01-0519 in the name of Amgen Inc. in the amount of \$ 410.00. A duplicate copy of this petition is attached.

☒ If an additional extension of time is required, please consider this a request therefore.☒ The Commissioner is hereby authorized to charge any additional fees which may be required by the accompanying papers, or credit any overpayment to Deposit Account No. 01-0519.

Please Send Future Correspondence To:

US Patent Operations/[TJG]

Dept. 4300, M/S 27-4-A

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Date: May 7, 2003

EXPRESS MAIL CERTIFICATE

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Date of Deposit: May 7, 2003

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22315-1450.

Lynne Buchsbaum

Printed Name

Lynne Buchsbaum

Signature

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